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File ID & No.: ER 1604.02 US

PATENT

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In re the Application of:

David E. Allport

Serial No.: 09/874,450

Filed: June 5, 2001

For: METHOD OF CONTROLLING
MULTI-USER ACCESS TO THE
FUNCTIONALITY OF CONSUMER
DEVICES§
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Art Unit: 2673

Examiner: NGUYEN, Jimmy H.

Confirmation No.: 6282

Attorney Docket No.: ER 1604.02 US

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO THE COMMISSIONER

Sir:

Applicant hereby petitions the Commissioner under 37 C.F.R. 1.182 to review:

- 1) The Examiner's claim that drawings must be shown to understand the present invention; and alternatively
- 2) The Examiner's refusal to enter the new drawings in the present application;

A. Statement of Facts

Applicant filed the present patent application on 6/5/2001. In an office action dated 4/8/2003, in paragraph 3, the Examiner objected to the drawings and appeared to require the Applicant to submit flowcharts to support the claims. In response, Applicant

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submitted new drawings 6-11 to support the claims. In a subsequent final office action dated 9/24/2003, the Examiner accepted new drawing 6 (in paragraph 4) and rejected new drawings 7-11 (also in paragraph 4) as containing new matter.

B. Points To Be Reviewed

I.

Whether the Examiner erred when he claimed that drawings must be shown to understand the present invention.

II.

Whether the Examiner erred when he refused to enter new drawings 7-11 in the present application.

C. Memorandum

I.

The Examiner should not have required submission of new drawings 6-11 because they are not required to understand the present invention

It is the Applicant's contention that drawings do not need to be submitted in the present case to understand the present invention. The Examiner has repeatedly rejected the claims based on 37 CFR 1.83(a) (See Office Actions dated 4/8/2003 and 9/24/2003). It appears in the first Office Action that the Examiner required the Applicant to move information originally disclosed in the specification and claims to the figures as well (See paragraph 3 of the Office Action dated 4/8/2003). However, it is not required

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that the drawings show all of the features of the claims in all cases as the Examiner has asserted. It is only required when it is necessary to understand the invention. An application, in fact could be submitted with no drawings if they are not needed. (Please see 37 C.F.R. 1.81). It is applicant's contention that the examiner should not reject the present drawings under 37 C.F.R. 1.83 if they are not necessary under 37 C.F.R. 1.81.

In the present case it is not necessary to include the matter submitted in new drawings 6-11 to understand the invention. However based on the information in the Office Action dated 4/8/2003, Applicant converted the disclosure in the specification to new figures as well to advance the prosecution of the case. In the next, final Office Action dated 9/24/2003, the Examiner accepted new drawing 6, but would not accept new drawings 7-11.

New drawing 7 though is identical to new drawing 6, except in box 710, several factors are listed. These factors were originally disclosed in the specification (see page 12, first paragraph) and they simply have been moved from the original specification to the new figure 7. These factors are not complicated and should be understood by anyone skilled in the art, even without a figure. Applicant asserts that it would not be needed in understanding the invention to include such factors as "time of day or night for log in or log off", "the screen last viewed", etc in a figure (see box 710 of new figure 7). They are simply factors that are understood by their plain meaning. Therefore, it is incorrect to reject new figure 7 as being required to understand the invention.

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The same holds true for new figures 8-11. They simply re-iterate information originally disclosed in the specification where that information is understandable without a figure. Figures 8 and 9 illustrate how the device might switch states. However, it does not require a flow chart for one skilled in the art to understand that if a factor is used to decide whether to switch states, and if the device is in a first state, then it might switch to the second state based on the factor (see, for instance boxes 810 and 815 of new figure 8 and boxes 920 and 930 of new figure 9). There is an inherent ordering to these steps that with or without a flowchart would be understood by someone skilled in the art.

The disclosure to support new figure 10 is found at page 13, line 9 to page 14, line 10. It simply defines a group user, establishes a group user state, and modifies the group user state based on input from either the first or second user. There is an inherent ordering to those steps that are understandable to one skilled in the art without a flowchart, for instance, the group user must be defined (block 1000) before it is established (block 1010) and input must occur (1020) to initiate the modification of the group user state (1030).

The disclosure for figure 11 is found, for instance, at page 5 first paragraph and page 11, lines 20-23 to page 12, line 10. It merely describes the process of a new user logging in and receiving a system state based on preferences and previous use states. This process is disclosed fully in the specification and the ordering of the steps is implicit, since there must be a bio-metric input of a different user (1110) before steps 1120 and 1130 which obtain previous use states and preferences for the different user.

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Similarly steps 1140 and 1150 occur after the system uses 1120 and 1130 to determine the state. These steps are implicit and understandable without a figure. Therefore, Applicant asserts that the Examiner erred when requiring Applicant to submit new figures 6-11 to understand the present invention.

II.

**Even if new drawings 6-11 are required to understand the invention,
they do not add new matter as the Examiner has asserted**

New drawings 6-11 do not add new matter as the Examiner has suggested. Instead, the new drawings simply reiterate disclosure already in the specification and move that disclosure to figures as well. Such an amendment is permissible and does not add new matter. In the office action dated 9/24/2003 the Examiner accepted new figure 6 as not containing new matter, but rejected figures 7-11 as containing new matter.

However, if new figure 6 is acceptable as not containing new matter, then new figure 7 should also be acceptable for the same reason. New figure 7 is identical to new figure 6, except in block 710, various factors are listed that are used in establishing the system state. These are the same factors that were originally disclosed in the specification (see, for instance, page 12, first paragraph). It is clear to one skilled in the art what these factors are by their plain meaning and moving them to box 710 in Figure 7 should not be seen as adding new matter.

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Figures 8-9 should also not be seen as adding new matter. Figures 8 and 9 merely restate information shown in the specification. Decision blocks 815 of Figure 8 and 930 of Figure 9 should be seen as implicit in the original disclosure, since an algorithm is discussed in the specification (see, for instance, page 12, second paragraph of the original patent application). There, an algorithm is described that might cause the system to switch states. Thus, by definition the system might transfer from a first to a second state. Implicit in that, the algorithm within the computing device must decide whether to switch at a certain time and this implies a decision as shown in blocks 815 and 930.

New figures 10-11 contain disclosure directly described in the specification and have simply been shifted to figures. The disclosure to support new figure 10 is found at page 13, line 9 to page 14, line 10. There, blocks 1000 and 1010 are described. Thereafter, on page 13, lines 15-18 the first user passes the device to the second user who provides a thumbprint, thereafter the device switches to the second user's state. Clearly, this thumbprint implies input to the device at block 1020 and should not be seen as new matter.

The disclosure for figure 11 is found, for instance, at page 5 first paragraph and page 11, lines 20-23 to page 12, line 10. Figure 11 is identical to new figure 6, which the Examiner has accepted, except it adds blocks 1120 and 1130. The user's previous use states and preferences, however, are clearly described in the original disclosure

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and should not be seen as new matter, when shifted to the figures this way.

The Examiner objects, in part, to the fact that figures 7-11 introduce ordered steps that he feels add new matter. (see page 2, paragraph 5 of the office action dated 9/24/2003) Applicant respectfully disagrees. The ordered steps should be clear from the disclosure of the specification without resort to the new figures. The present application simply would not be logical if certain orderings were not inherent in the disclosure.

For instance in Figure 7 a first user accesses a controller (700), then a second user provides bio metric input (705), the controller accesses information (factors) for the second user (710), establishes a system state (715), and provides the second user access to the device (720). With or without a figure there is simply a logical order to these steps that is clear from the disclosure. Certainly, the second user would not access the device (720) before logging in (705). Similarly, the device wouldn't be able to retrieve the system state (715) without looking up factors (710). Thus the disclosure that was re-written as new Figure 7 has an inherent order and showing this order as a figure is not the addition of new matter.

Similarly, in Figure 8, blocks 810, 815, and 820 are inherently ordered because the system must access factors (810) before deciding if it needs to switch states (815) and then switches states (820), if so. In figure 9, the same is true of blocks 920, 930, and 940. In figure 10 there is an inherent ordering to the steps, for instance, the group user

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must be defined (block 1000) before it is established (block 1010) and input must occur (1020) to initiate the modification of the group user state (1030). Similarly, Figure 11, which is identical to Figure 6, which has been accepted, merely adds blocks 1120 and 1130, the user's preferences and previous use states. Certainly, these steps must occur between a new bio-metric input (1110) and establishing a new system state (1140). For these reasons, Applicant feels the Examiner has erred in rejecting new figures 7-11 as containing new matter.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 04-1175.

Respectfully Submitted,


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Date: November 24, 2003

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